UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,192	12/15/2003	Kenneth A. Williams	06975-221002	2149

26171 7590 04/27/2009
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
DUFFY, DAVID W	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
04/27/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No.	Applicant(s)	
	10/734,192	WILLIAMS ET AL.	
	Examiner	Art Unit	
	DAVID DUFFY	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-39 and 42-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-39 and 42-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This office action is in response to the amendment filed 01/22/2009 in which applicant adds claims 42-54. Claims 12-39 and 42-54 are pending.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 12, 15-18, 20-21, 24-27, 29-32, 34-35 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over "How to get the most out of COMPUSERVE, 4th edition, 1989" (hereafter Bowen).

4. In regards to claims 12 and 17-18, Bowen discloses a computer implemented method of creating a user profile for interacting on a computer network, the method comprising enabling a first user to identify profile information with respect to each of one or more items (pgs 94-95, 207-209, and 381: "create and read personal bios"); and enabling the first user to make the profile information accessible to a first remote computer system, a central computer system, and at least one other remote computer system (pg 207-209, making a profile while online for other members to view), wherein the first computer system, the central computer system, and at least one other remote computer system are elements of a computer network used for multi-user communications (CompuServe is an online multi-user environment). Bowen does not explicitly disclose that the interface enables user determination of the skill of a first user for a first identified video game relative to a second video game or players identifying

skill and interest levels in said games. However, as Bowen explains, users may enter any information they wish into their list of interests (pg. 208) and further describes that the system allows for multiplayer games with an active player base that engages in team and competitive play (pg 377-390). Given such a system, it would have been obvious to one of ordinary skill in the art at the time that the user could have included games as an interest and in order to facilitate team creation and competitive play, provided an indication of player skill in the said games so that other users may find players of the skill level desired to play against.

5. In regards to claims 15 and 24-25, Bowen discloses the method of claim 12, but lacks wherein the profile information is automatically rendered upon the first user inviting a second user to play a game. However, Bowen discloses the ability of a user to look up other user's profiles (pg 208, search by) and it would have been obvious to automate the manual task of searching to allow a user to view profile information of a selected user directly thus saving time while matchmaking.

6. In regards to claim 16, Bowen discloses the method of claim 12, but lacks wherein the profile information is automatically displayed upon the second user taking an action demonstrating an interest in the first user. However, Bowen discloses the ability of a user to look up other user's profiles (pg 208, search by) and it would have been obvious to automate the manual task of searching to allow a user to view profile information of a selected user directly thus saving time.

7. In regards to claim 20, Bowen discloses the method of claim 12 further comprising enabling the first user to identify personal characteristics; enabling the first

user to save the personal characteristics; and enabling the first user to make the personal characteristics accessible to a first remote computer system, a central computer system, and at least one other remote computer system (pgs 94-95, 207-209, and 381: "create and read personal bios").

8. In regards to claim 21, Bowen discloses a user identifying personal characteristics including interests such as gardening (pg 208) which examiner contends is also a hobby.

9. In regards to claim 26, Bowen discloses that players may engage in chess (pg 373), but does not explicitly disclose checkers. However, as checkers is a common game played since at least 1900, it would have been obvious that players may have listed checkers as an interest and provided their skill at said game in their player profiles.

10. In regards to claims 27, 29-32, 34-35 and 38-39, Bowen discloses the system of claims 12, 15-18, 20-21 and 24-26 above where a user makes profile information available to others. Claims 27, 29-32, 34-35 and 38-39 are directed to a first user accessing the information of second user. As Bowen teaches the system of claim 12 above including a multi-user online environment where users may search each other's profiles (pg 208 search by), it also teaches a first user accessing another user's profile.

11. Claims 13-14, 22-23, 28, 36-37, and 42-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowen in view of Brittin; Ruth, The Effect of Categorization on Preferences for Popular Music Styles.

12. In regards to claims 13-14 and 28, Bowen discloses the system set forth above where it would be inherent that the player profile would allow a user to determine the relative skill of a player in various games by looking at the listing of games and the associated player skill levels, but does not explicitly disclose using a normalized scale for users to indicate their level of skill.

13. In related prior art, Brittin discloses a survey presented to participants to determine their interest level in various musical genres (pg. 72, Conventional Preference Ratings) using a Likert scale. A Likert scale being well known as a method for rating preference or agreement, one skilled in the art would recognize the advantages of allowing users to use a normalized Likert scale to rate their ability in a game in order to provide a common measure so that players may find players of the skill level they desire to play against.

14. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Bowen in view of Brittin to have allowed users to use a Likert normalized scale to identify their skill in a game in the profile of the player so that other players may readily determine the skill level and find teammates or competitors of the skill level they desire.

15. In regards to claims 22-23 and 36-37, Bowen discloses the system set forth above, but does not explicitly disclose that the skill level is chosen from gradations of skill including little, intermediate or great skill.

16. In related prior art, Brittin discloses a survey presented to participants to determine their interest level in various musical genres (pg. 72, Conventional

Preference Ratings) using a Likert scale. A Likert scale being well known as a method for rating preference or agreement, one skilled in the art would recognize the advantages of allowing users to use a normalized Likert scale to rate their ability in a game in order to provide a common measure so that players may find players of the skill level they desire to play against.

17. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Bowen in view of Brittin to have allowed users to use a Likert normalized scale to identify their skill in a game in the profile of the player so that other players may readily determine the skill level and find teammates or competitors of the skill level they desire. The combination made does not explicitly disclose that the gradations of skill include relatively little, relatively intermediate, and relatively great skill. However, the metric used to provide skill level information to potential teammates or competitors would have been a matter of obvious choice as the user would have reasonable expected a scale of 1-5 or little-great to provide a scale indicating the level of skill, differing only in the terms used to define the skill levels. Accordingly, the limitation fails to distinguish over the prior art.

18. In regards to claims 42-45, 47-52 and 54, Bowen discloses a computer implemented method of creating a user profile for interacting on a computer network, the method comprising enabling a first user to identify profile information with respect to each of one or more items (pgs 94-95, 207-209, and 381: "create and read personal bios"); and enabling the first user to make the profile information accessible to a first remote computer system, a central computer system, and at least one other remote

computer system (pg 207-209, making a profile while online for other members to view), wherein the first computer system, the central computer system, and at least one other remote computer system are elements of a computer network used for multi-user communications (CompuServe is an online multi-user environment). Bowen does not explicitly disclose that the interface enables the user to have games as areas of interest. However, as Bowen explains, users may enter any information they wish into their list of interests (pg. 208) and further describes that the system allows for multiplayer games with an active player base that engages in team and competitive play (pg 377-390). Given such a system, it would have been obvious to one of ordinary skill in the art at the time that the user could have included games as an interest and in order to facilitate team creation and competitive play, provided an indication of player skill in the said games so that other users may find players of the skill level desired to play against. Bowen does not explicitly disclose that the skill or interest level is chosen from gradations of skill including little, intermediate or great skill or interest.

19. In related prior art, Brittin discloses a survey presented to participants to determine their interest level in various musical genres (pg. 72, Conventional Preference Ratings) using a Likert scale. A Likert scale being well known as a method for rating preference or agreement, one skilled in the art would recognize the advantages of allowing users to use a normalized Likert scale to rate their ability and interest in a game in order to provide a common measure so that players may find players of the skill and interest level they desire to play against.

20. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Bowen in view of Brittin to have allowed users to use a Likert normalized scale to identify their skill and interest in a game in the profile of the player so that other players may readily determine the skill level and find teammates or competitors of the skill and interest level they desire. The combination made does not explicitly disclose that the gradations of skill and interest include relatively little, relatively intermediate, and relatively great skill. However, the metric used to provide skill level information to potential teammates or competitors would have been a matter of obvious choice as the user would have reasonable expected a scale of 1-5 or little-great to provide a scale indicating the level of skill or interest, differing only in the terms used to define the skill or interest levels. Accordingly, the limitation fails to distinguish over the prior art.

21. In regards to claims 46 and 53, Bowen in view of Brittin teaches the system set forth above whereby a user may include in their profile a list of interests and an associated interest and skill level, But does not explicitly disclose that the ratings are displayed with graphics. However, it would have been a matter of obvious design choice, well within the abilities of one of ordinary skill in the art at the time to have used graphical indicators for skill and interest levels as such a modification would just be changing the form of the information presented without altering the content. Furthermore, one of ordinary skill would have expected either a picture of a scale or words describing the position on a Likert scale to accomplish the goal of providing information to the user and other users.

22. Claims 19 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowen in view of Stults; Robert A. et al. (US 4987492).

23. In regards to claim 19, Bowen discloses the method of claim 12 above and further discloses that it is desirable for users to be able to see images of other users (pg 410), but lacks comprising: enabling the first user to select a visage; enabling the first user to save the visage; and enabling the first user to make the visage accessible to a first remote computer system, a central computer system, and at least one other remote computer system.

24. In related prior art, Stults discloses a technique by which a user is able to control an audio/video communication system in a computer network system where visages are used to represent users of a particular computer (6:63-66) and further states any other visual cues could be used, including an image of a face, a name, a character, a number and the like (6:66-7:2). One skilled in the art would recognize the advantages of being able to identify a user visually to provide easily recognizable indicators of users and allow users to see each other over a network.

25. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Bowen in view of Stults in order to include a visage of users to facilitate identification and improve the user's experience while using the networked communication system.

26. In regards to claim 33, Bowen discloses the method of claim 27 above and further discloses that it is desirable for users to be able to see images of other users (pg 410), but lacks comprising enabling the first user to access a visage of the second user.

27. In related prior art, Stults discloses a technique by which a user is able to control an audio/video communication system in a computer network system where visages are used to represent users of a particular computer (6:63-66) and further states any other visual cues could be used, including an image of a face, a name, a character, a number and the like (6:66-7:2). One skilled in the art would recognize the advantages of being able to identify a user visually to provide easily recognizable indicators of users and allow users to see each other over a network.

28. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Bowen in view of Stults in order to include a visage of users to facilitate identification and improve the user's experience while using the networked communication system.

Response to Arguments

29. Applicant's arguments filed 01/22/2009 have been fully considered but they are not persuasive. Applicant argues that Bowen does not include skill level in games. Examiner disagrees. Bowen allows a user to enter any information they desire into their profile and disclose an extensive gaming section. It is reasonable to assume that those using the CompuServe system might therefore consider some of the games provided as an interest and would therefore list such interests in their profile. It is also reasonable that as the games of CompuServe involve competitive play against other individuals, the players would want to be able to find other players, further suggesting including the games of interest in a player's profile so that they may be found to compete against. Furthermore, as players engaging in competition with each other it is reasonable to

assume that the player would want to find an opponent that would be entertaining to play against. As player skill would be the main variable in the enjoyment of a game, players would be motivated to include an indication of their skill at a game so that they may find players of a desired skill level with which to compete. Rating of players was widely know at the time of invention in many gaming circles such as chess and sports games (i.e. baseball player cards with skill indication based on stats) and it therefore would have been obvious to provide an indication of player skill to facilitate matchmaking and enjoyable competition.

30. One of ordinary skill in the art is presumed to have skills apart from what the prior art references expressly disclose. *In re Sovish,* 769 F.2d 738, 743 (Fed. Cir. 1985). A person of ordinary skill is also a person of ordinary creativity, not an automaton. *KSR,* 127 S.Ct. at 1742. Furthermore, the *KSR* Court recognized that "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp." *KSR,* 127 S.Ct. at 1732.

31. Additionally, in *KSR,* the Supreme Court explained that a "rigid" teaching, suggestion, motivation ("TSM") test "is incompatible with our precedents." *KSR,* 127 S.Ct. at 1741. A rigid requirement of relying on only what is written in a prior art reference would, as the Supreme Court noted, unduly confine the use of the knowledge and creativity within the ordinary grasp of an ordinarily skilled artisan, *Id.* at 1742.

32. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID DUFFY whose telephone number is (571) 272-1574. The examiner can normally be reached on M-F 0830-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D./
Examiner, Art Unit 3714

/Corbett Coburn/
Primary Examiner
AU 3714